

Appl. No. : 10/032,215
Filed : December 21, 2001

REMARKS

In the outstanding Office Action, the Examiner has rejected Claims 1-17 and 19-21, and objected to Claim 18. Claims 1, 3, 4, 10, 12, 17, and 19-21 have been amended, and Claim 22-30 have been added. No new matter has been added. Thus, Claims 1-30 are presented for further examination. Reconsideration and allowance of all Claims 1-30 in light of the present remarks is respectfully requested.

Claims 3, 4, 12, and 19-21 are amended to clarify that the upper and lower portions referred to are the "perforated upper portion" and "perforated lower portion" recited in the independent claims. In addition, Claim 17 is amended to insert a period. These amendments are made to address typographical errors and are not made for reasons of patentability. Thus, these amendments do not narrow the scope of protection.

Rejections Under 35 U.S.C. § 102(b)

The Examiner has rejected Claims 1-17 under 35 U.S.C. § 102(b) as anticipated by WIPO publication no. WO 97/26448 to Vogrin.

In regard to Claim 1, the Examiner stated that "Vogrin discloses an adapter body 11 including an upper perforated portion and a lower perforated portion (see the perforations 24 and 25 in FIGS. 1 and 3), a centrally located opening (e.g., receiving part 13, see FIGS. 2 and 3) passing through the upper and lower portions, a hollow insert 13 (see FIG. 2) mounted inside the opening ... , and a magnet 17 disposed within the adapter body".

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053.

Amended Claim 1 recites a magnetic filter adapter comprising "a removable hollow insert mounted inside said opening, extending through said perforated upper portion and said perforated lower portion". As illustrated in Figure 2 of Vogrin, the central channel portion 13 of the removable cartridge 11 is not "removable". More particularly, the central channel portion 13 is formed continuously with the cartridge housing as a single piece, and is therefore not removable. Although Vogrin's FIG. 1 does not fully illustrate the central channel portion 13, the discussion of Figure 2 indicates that the cartridge illustrated in Figure 2 is the same shape as illustrated in

Appl. No. : 10/032,215
Filed : December 21, 2001

Figure 1, except that the chamber 16 contains magnetic means arranged in bulk inside the chamber. *FLS, Inc. translation of Vogrin at page 6, para. 1.*

In addition, with respect to the embodiment illustrated in Figure 3 of Vogrin, the projecting portion of the cover 42 does not extend through the upper portion and the lower portion of the cartridge 11. Furthermore, the central channel portion 13 of the cartridge 11 is again illustrated in Figure 3 as being formed continuously with the housing of the cartridge 11.

Thus, as Vogrin fails to describe, either expressly or inherently, every element as set forth in amended Claim 1, Applicant respectfully submits amended Claim 1 for further review as patentable subject matter.

The removable hollow insert of the adapter provides many advantages, as discussed in Applicant's specification at paragraphs [0018], [0023], and [0032]. For example, a plurality of different inserts having various combinations of threaded portions for attaching the insert to threaded studs and filters can be inserted into the adapter body. Thereby, a single filter adapter body can be used in a plurality of application environments by simply replacing the removable hollow insert.

As amended Claim 10 recites limitations similar to those recited in Claim 1, the arguments with respect to Claim 1 similarly apply to Claim 10, and thus, Claim 10 is respectfully submitted for further review as patentable subject matter.

Because Claims 2-9, 11-18, and 30 depend from Claims 1 and 10, pursuant to 35 U.S.C. § 112, ¶ 4, they incorporate by reference all the limitations of the claim to which they refer. It is therefore submitted that these claims are in condition for allowance at least for the reasons expressed with respect to the independent claim, and for their other features. For all of these reasons, Applicant respectfully requests withdrawal of this rejection.

Rejections Under 35 U.S.C. § 103

The Examiner has rejected Claims 19-21 under 35 U.S.C. § 103(a) as being unpatentable over WIPO publication no. WO 97/26448 to Vogrin in view of U.S. Patent No. 4,237,015 to Fearnhead.

In regard to Claim 19, the Examiner stated that "Vogrin discloses inserting a magnet 17 (see FIGS. 1 and 3) in an adapter housing 11 having an upper perforated portion and a lower perforated portion, and inserting a hollow insert 13 in a centrally located opening passing through

Appl. No. : 10/032,215
Filed : December 21, 2001

the upper portion, the lower portion, and the magnet." The Examiner recognized that Vogrin "fails to specify placing the magnet in the perforated lower portion followed by enclosing the magnet in the adapter by attaching a perforated upper portion of a housing to the perforated lower portion." However, the Examiner further stated that "Fearnhead discloses that its known to enclose a filter member within a housing by first placing the filter member in a lower portion 11 of the housing followed by enclosing the filter member in the housing by attaching a perforated upper portion 13 to the lower portion".

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 180 U.S.P.Q. 580.

Claim 19 recites a method of assembling an adapter for removing metallic particles from a fluid by "inserting a magnet in a perforated lower portion of a housing of said adapter; enclosing said magnet in said adapter by attaching a perforated upper portion of a housing of said adapter to said perforated lower portion; and inserting a hollow insert in a centrally located opening passing through said perforated upper portion, said perforated lower portion, and said magnet."

As discussed above with respect to Claim 1 and illustrated in Figures 2-3 of Vogrin, the central channel portion 13 of the removable cartridge 11 is not "inserted into a centrally located opening" as recited in Claim 19. More particularly, the central channel portion 13 is formed continuously with the cartridge housing as a single piece, and therefore cannot be "inserted" as part of a method of assembly of an adapter as recited in Claim 19.

In addition, with respect to the embodiment illustrated in Figure 3 of Vogrin, the cover 42 for the casing 40 is not inserted in "a centrally located opening passing through said perforated upper portion, said perforated lower portion, and said magnet" as recited in Claim 19. Specifically, the cover 42 does not pass through a perforated lower portion of the cartridge 11.

Furthermore, Fearnhead fails to teach or suggest inserting a hollow insert in a centrally located opening passing through a perforated upper portion, a perforated lower portion, and a magnet, as recited in Claim 19.

Thus, as neither Vogrin nor Fearnhead, either alone or in combination, teach or suggest every element as recited in Claim 19, Applicant respectfully submits that Claim 19 is in condition for allowance.

Appl. No. : 10/032,215
Filed : December 21, 2001

Consequently, because they incorporate all of the limitations of the claim from which they depend, Claims 20-21 also define patentable subject matter for at least the same reasons as set forth above with respect to the independent claim.

New Claims

New Claim 22 has been added. The adapter of Claim 22 comprises, *inter alia*, "a magnet disposed within said adapter body for removing metallic particles from said fluid, wherein said magnet has a central opening adapted to circumscribe said hollow insert so as to allow fluid to flow between said hollow insert and said magnet."

The Examiner stated that "the prior art fails to specify the magnet as being mounted by the spacers such that a gap exists between the inner bore of the magnet and the outer surface of the hollow insert to permit fluid to circulate therebetween". Thus, Applicant respectfully submits that the prior art fails to teach or suggest every element as recited in Claim 22. Therefore, Claim 22 is respectfully submitted as being in condition for allowance.

Because Claims 23-29 depend from Claim 22, pursuant to 35 U.S.C. § 112, ¶ 4, they incorporate by reference all the limitations of the claim to which they refer. It is therefore submitted that these claims are in condition for allowance at least for the reasons expressed with respect to the independent claim, and for their other features.

CONCLUSION

Applicant has endeavored to address all of the Examiner's concerns as expressed in the outstanding Office Action. Accordingly, amendments to the claims for patentability purposes pursuant to statutory sections 102, and/or 103, the reasons therefor, and arguments in support of the patentability of the pending claim set are presented above. In light of these amendments and remarks, reconsideration and withdrawal of the outstanding rejections is respectfully requested.

Any new claims presented above are simply additional specific statements of inventive concepts described in the application as originally filed.


Appl. No. : 10/032,215
Filed : December 21, 2001

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE MARTENS, OLSON & BEAR, LLP

Dated: September 12, 2003

By: 

Michael L. Fuller
Registration No. 36,516
Attorney of Record
Customer No. 20,995
(619) 235-8550

AMEND
S:\DOCS\TCM\TCM-2399.DOC
081303

RECEIVED
CENTRAL FAX CENTER
SEP 15 2003

OFFICIAL